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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,039	02/08/2001	Gregory S. Friedrichs	AM100143	4428
25291	7590	03/09/2004	EXAMINER	
WYETH PATENT LAW GROUP FIVE GIRALDA FARMS MADISON, NJ 07940			MURPHY, JOSEPH F	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,039

Applicant(s)

FRIEDRICHS ET AL.

Examiner

Joseph F Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 12 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) 6, 12 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/2004 has been entered.

Formal Matters

Claims 6, 12, 17-23 are pending. Claims 6, 12, 17 stand withdrawn from consideration pursuant to 37 CFR 1.142(B). Claims 18-23 are under consideration.

Response to Amendment

The rejections over claims 1-5, 7, 9-11, 13-16 have been rendered moot by cancellation of the claims, and are thus withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 18, 20-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Deswal et al. (1999).

Deswal et al. teaches the selection of patients in need of therapy for an ischemic event in a mammal, and the administration of a TNF antagonist to treat said mammal. In this study

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Eighteen NYHA class III heart failure patients were randomized into a double-blind dose-escalation study to examine the safety and potential efficacy of etanercept, a specific TNF antagonist (Enbrel) (Deswal at 3224). Etanercept contains 2 molecules of the extracellular domain of sTNFR2 linked to the Fc portion of the IgG1 molecule (Ibid. at 3225). Of the patients enrolled in the study, 4 had ischemic heart disease (Ibid. at 3225, Table I), thus claims 18, 20-23 are anticipated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deswal et al. (1999) in view of US Patent No. 5,696,109 (Malfroy-Camine et al.).

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Deswal et al. teaches the selection of patients in need of therapy for an ischemic event in a mammal, and the administration of a TNF antagonist to treat said mammal. In this study Eighteen NYHA class III heart failure patients were randomized into a double-blind dose-escalation study to examine the safety and potential efficacy of etanercept, a specific TNF antagonist (Enbrel) (Deswal at 3224). Etanercept contains 2 molecules of the extracellular domain of sTNFR2 linked to the Fc portion of the IgG1 molecule (Ibid. at 3225). Of the patients enrolled in the study, 4 had ischemic heart disease (Ibid. at 3225, Table I). Deswal et al. does not teach the method wherein the ischemic event is caused by bypass surgery or transplantation. However, the '109 patent discloses that bypass surgery and transplantation are ischemic events. Therefore, it would have been obvious to one of skill in the art at the time the invention was made to practice a method of the administration of a TNF α antagonist following an ischemic event wherein the ischemic event is bypass surgery or transplantation. The motivation is provided in the Deswal reference which teaches that TNF is a potentially important therapeutic target in heart failure patients (Deswal at 3226, first column, first paragraph). The expectation of success is provided in the Deswal reference which shows that etanercept can be given safely to heart failure patients (Deswal at 3226, second column, first paragraph).

Conclusion

No claim is allowed.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Murphy whose telephone number is (571) 272-0877. The examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272-0871.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
February 24, 2004